

REMARKS

Appreciation is hereby expressed to Examiner Sharmilla Gollamudi for the telephone interview so courteously granted on October 25, 2004. Pursuant to that interview, the second paragraph on page 34 has been amended as suggested by the Examiner and Claims 3, 5-7, 9, 10, and 14 have been cancelled. In addition, Claims 1, 8, 11, 12 and 17 have been amended to incorporate the subject matter which was discussed with the Examiner during the interview, i.e., subject matter originally in the claims which would not raise new issues and/or require an additional search. The present amendment is deemed not to introduce new matter. Claims 1, 8, 11, 12, 13 and 17 are presently in the case, Claim 13 having been withdrawn from consideration as being drawn to a non-elected invention.

Reconsideration is respectfully requested of the objection to the Specification as amended by the amendment filed on March 30, 2004. The reference to ethylene glycol diglycidylether and weight of water inserted in the second paragraph on page 34 has been corrected. Therefore, the Examiner's objection to the Specification is now believed to be moot. Withdrawal of the objection is accordingly respectfully requested.

Reconsideration is respectfully requested of the rejection of Claims 1, 3, 5-12, 14 and 17 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. Claim 1 has been amended to recite that the weight ratio of the drug in free form to the polyacrylic acid is in the range of 3:1 to 1:3, the ratio referenced by the Examiner in the rejection. It is therefore believed that this rejection is now moot. Withdrawal of the rejection is accordingly respectfully requested.

Reconsideration is respectfully requested of the rejection of Claims 1, 3 and 14 under 35 U.S.C. § 102(b) as anticipated by WO 96/24352. There is no disclosure in WO 96/24352 of an adhesive gel composition comprising 1 to 20% of weight of lidocaine and 0.001 to 0.5% by weight of epiprine both in free form, together with a polyacrylic acid, polyepoxy compound, water, polyhydric alcohol and/or gelatin, and an antioxidant, and wherein the weight ratio of the drugs in free form to the polyacrylic acid is in the range of from 3:1 to 1:3. On the contrary, that teaching or suggestion comes only from the present application and from Claim 1 as amended, and constitutes an important element or aspect of the present invention.

Failing a disclosure of the composition as now called for in the claims herein, it is respectfully submitted that the WO 96/24352 reference in no way anticipates or renders unpatentably obvious the subject matter as now required by the claims herein. Consequently, the Examiner would be justified in no longer maintaining the rejection. Withdrawal of the rejection is accordingly respectfully requested.

Reconsideration is respectfully requested of the rejection of Claims 5-12 and 17 under 35 U.S.C. § 103(a) as being unpatentable over WO 96/24352 in view of Linkwitz, et al..

The WO 96/24352 reference is discussed above.

It is respectfully submitted that Linkwitz, et al. is not a proper reference in a 103 rejection because it has a patent date of September 25, 2001. However, the present application has a priority date of November 26, 1998, long prior to the issue date of Linkwitz, et al. It is also respectfully submitted that applicant filed with this initial application a claim for priority together with a form PCT/1B/304 from the International Bureau. On the basis of this claim for priority the United States Patent and Trademark Office granted applicants' filing date of November 10,

1999 and a priority date of November 26, 1998. Thus, it can be seen that the effective filing date of the present application antedates the issue date of Linkwitz, et al. Therefore, the Linkwitz reference is not prior art.

Since the rejection is based on the WO 96/24352 in view of Linkwitz, et al., it is respectfully submitted that the rejection fails, as a matter of law, because the Linkwitz, et al. reference is not prior art. Therefore, the Examiner would be justified in no longer maintaining this rejection. Withdrawal of the rejection is accordingly respectfully requested.

Reconsideration is respectfully requested of the rejection of Claims 11 and 17 under 35 U.S.C. §103(a) as being unpatentable over WO 96/24352 in view of Linkwitz, et al. and further view of JP 08-325149.

Both WO 96/24352 and Linkwitz, et al. are discussed above.

The secondary reference of JP 08-325149 like the other prior art of record fails to disclose an adhesive gel composition for iontophoresis as now called for in Claim 1 herein, that is a gel composition containing 1 to 20% by weight of lidocaine and 0.001 to 0.5% by weight of epiprine both in free form, together with a polyacrylic acid poly-functional epoxy compound, water, polyhydric alcohol, and/or gelatin together with an antioxidant and wherein the weight ratio of the drug in free form to the polyacrylic acid is in a range of 3:1 to 1:3. On the contrary, that teaching comes only from the present application and constitute an important element or aspect of the present invention. For these reasons, and in view of the fact that Linkwitz, et al. is not prior art, it is respectfully submitted that the Examiner would be justified in no longer maintaining the rejection. Withdrawal of the rejection is accordingly respectfully requested.

Reconsideration is respectfully requested of the rejection of Claims 1, 3, 5 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Oda, et al. Claim 1 has been extensively amended to set forth with particularity the components of the adhesive gel composition of the present invention. Specifically, the gel composition now calls for 1 to 20% by weight of lidocaine and 0.001 to 0.5% by weight of epiprine both in free form. Also required in Claim 1 is a polyacrylic acid, a polyfunctional epoxy compound, water, polyhydric alcohol, and/or gelatin together with an antioxidant wherein the weight ratio of the drugs in free form to polyacrylic acid is in the range of 3:1 to 1:3. It is believed that this particular composition is nowhere disclosed in the Oda, et al. reference. Therefore, it is believed that the Examiner would be justified in no longer maintaining the rejection. Withdrawal of the rejection is accordingly respectfully requested.

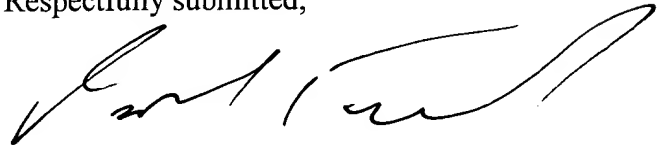
Reconsideration is respectfully requested of the rejection of Claims 5-10 and 12 under 35 U.S.C. § 103(a) as being unpatentable over Oda, et al. in view of Lugnani, et al.

The Oda, et al. reference is discussed above.

The secondary reference of Lugnani, et al. has a patent date of December 1, 1998 which is after applicants' priority date of November 26, 1998. Therefore, it is respectfully submitted that the Lugnani, et al. reference is not prior art against the present application. Consequently, since the Examiner's secondary reference relied upon is not prior art, the rejection fails, as a matter of law. Consequently, the Examiner would be justified in no longer maintaining this rejection. Withdrawal of the rejection is respectfully requested.

In view of the foregoing, it is respectfully submitted that the claims now in the application are in condition for allowance, and early action and allowance thereof is accordingly respectfully requested. In the event there is any reason why the application cannot be allowed at the present time, it is respectfully requested that the Examiner contact the undersigned at the number listed below to resolve any problems.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Donald E. Townsend', written in a cursive style.

Donald E. Townsend
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